

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#8/Block  
2/26/03  
J. Butler

In the Application of : Docket: W9495-01  
WORMSBECHER, Richard Franklin : Date: February 10, 2003  
Serial No. 09/929,621 : Art Unit: 1723  
Filed: August 14, 2001 : Examiner: THERKORN, E

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TC 1700

For: **Solid Compositions for Selective Adsorption  
from Complex Mixtures**

Commissioner of Patents & Trademarks  
Washington, D.C. 20231

**ELECTION**

Sir:

In response to the Office Action dated December 10, 2002, the period for response thereto having been extended to February 10, 2003, in view of the Enclosed Request for Extension of Time of 1 month, Applicant hereby elects the invention of Group I, i.e., claims 1-23 and 47-54, for prosecution in the above-identified patent application. This Election is made with traverse.

**CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8**

Pursuant to 37 CFR §1.8, I hereby certify that I have a reasonable basis to expect that this correspondence will be deposited with the United States Postal Service on or before the date indicated, as First Class Mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231.

February 10, 2003  
Date

A. Scan  
Signature

In the Office Action, the basis for restricting the claims of Groups I and III is as follows:

Inventions I and III are related as process of making a product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other immaterially different product; or (2) that the product as claimed can be made by another immaterially different process (MPEP §806.05(f)). In the instant case, the product could be made by another immaterially different process. For example, the product could be made by agglomerating and  $R_{10}$  containing compound from solution.

Under MPEP §803, a restriction requirement is only appropriate if the inventions are independent or distinct and there is a serious burden on the Examiner.

The process recited in the claims of Group III, i.e., 38 - 46, requires that an  $R_{10}$  moiety is reacted with an inorganic substance to form the product. It is submitted that there is no other means, except via reaction, that the moiety  $R_{10}$  could be bonded to the inorganic substance. Moreover, for the identical reason the search and examination performed by the Examiner would not be a serious burden. Accordingly, the claims of Groups I and III are not distinct and examination of such claims would not be burdensome and thus withdrawal of the restriction requirement is respectfully submitted.

Applicant respectfully traverses the Election requirement also set forth in the December 10, 2002, Office Action. MPEP §806.04(f) requires that claims to be restricted to different species must be mutually exclusive. The general test as to when claims are restricted, respectively, to different species, is the fact that one claim recites limitations which under the disclosure are found in a first species but not in a second, while a second claim recites limitations disclosed only for the second species and not the first.

In the Office Action, Election I indicated that there are three distinct species. In particular, species 1 is an inorganic material without a binding moiety, which corresponds to claims 1-9; species 2 is an inorganic material with a binding moiety, which corresponds to claims 10-23; and species 3 is an inorganic material without a binding moiety and with a linker, which corresponds to claims 47-54. In all of these claims 1-23 and 47-54, there is recited common elements, such as an inorganic

substance and moiety  $R_{10}$ . Accordingly, these claims do not recite mutually exclusive characteristics and restriction is therefore improper.

Moreover, even if the embodiment set forth in claims 1-23 and 47-54 is considered to be combination and sub-combination, it is submitted that restriction is not proper. In particular, MPEP §806.05(c) requires that both 2-way distinctness and reasons for insisting on restriction, i.e. separate classification status, or field of search, is required for a proper restriction. In order to be distinct, it must be shown that a combination as claimed (1) does not require the particulars of the sub-combination as claimed for patentability, and (2) the sub-combination can be shown to have utility either by itself or in order and different relations. In the instant application, the sub-combination (i.e., an inorganic substance and moiety  $R_{10}$ ) is included in the combination of claims 10-23 (i.e., an inorganic substance, moiety  $R_{10}$  and at least one binding moiety), or combination of claims 47-54 (i.e., an inorganic substance, moiety  $R_{10}$  and at least one linker) and, is patentable. Accordingly, two-way distinctness of this combination and sub-combination has not been demonstrated. See also MPEP §806.05(c) II, the example that illustrates an improper restriction when a sub-combination is essential to a combination.

Accordingly, there is unity of invention among the species and genus/combination and sub-combination of the embodiments recited in claims 1-23 and 47-54 and withdrawal of Election I is respectfully requested.

With regard to Elections II, III, IV and V, the MPEP requires that if the members of a Markush Group are sufficiently few in number or are so closely related that a search and examination of the entire claims can be made without serious burden the Examiner must examine all claims on the merits, even though they are directed to independent and distinct inventions (MPEP §803.02). It is submitted that these species set forth in each of these Election requirements and recited in the instant claims are few in number and all perform similar functions and therefore have common utility. Thus, there is unity of invention among the species and withdrawal of the Election requirements is respectfully requested.

Applicant respectfully elects with traverse following species:

### **ELECTION I**

An inorganic material without a binding moiety and without a linker corresponding to claims 1-9;

### **ELECTION II**

An R<sub>10</sub> Group being -CH<sub>2</sub>OH, corresponding to claims 1, 3, 4, 17 and 54;

### **ELECTION III**

An inorganic substance being silica, corresponding to claims 7-9, 17-19 and 54;

### **ELECTION IV**

A binding moiety being a ligand and antibody, corresponding to claims 11 and 13; and

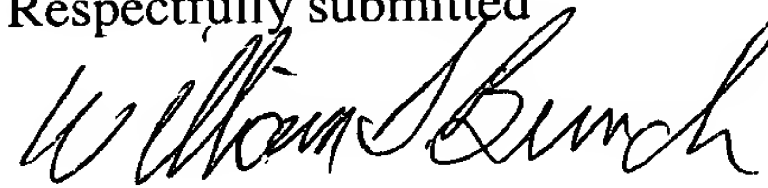
### **ELECTION V**

A linker being an amine, -N(R<sub>4</sub>)-, formed by reductive amination, corresponding to claims 20-23 and 49-51.

In the event that further information is required, please contact the undersigned at (410) 531 4333.

Finally, please note that copies of the references recited in the specification that were requested in the Office Action dated December 10, 2002, will be submitted shortly by way of an Information Disclosure Statement.

Respectfully submitted



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